

## **REMARKS**

### **Status of the Claims**

Claims 1-15 are pending. New claims 10-15 are added by this amendment. Reconsideration and allowance of all of the pending claims is respectfully requested.

New matter is not being added to the application by way of this amendment. New claim 10 is supported at page 8, line 12, and at page 5, lines 10-18, and further at page 6, lines 10-12 of the specification. New claims 11-15 are supported in original claims 2-6 respectively. Accordingly, no new matter is added, and entry of this amendment is respectfully requested.

### **Claim Rejections - 35 U.S.C. §102/103**

At page 2, paragraphs 1-3 of the Office Action, claims 1-7 and 9 are rejected under 35 U.S.C. §102(b) as anticipated by Obayashi '989 (U.S. Patent No. 4,863,989). At pages 3-4 of the Office Action, claim 8 is rejected under 35 U.S.C. §103(a) over Obayashi '989. For the following reasons, each of these rejections is respectfully traversed.

#### *1. The present invention*

The present invention provides a water-absorbent resin composition which simultaneously exhibits both good gel stability and discoloration resistance. The present invention is achieved by combining materials with an iron content that is very small, in order to adjust the total iron content of the water absorbent resin composition to 1 ppm or less.

In order to further clarify and better define the present invention, new process of making claims have been added to the application which incorporate the step of obtaining a water-absorbent resin composition, wherein the iron content is 1 ppm or less.

*2. Distinctions between the present invention and Obayashi '989*

It is well established under U.S. law that in order to find either anticipation or obviousness, the Office must first show that each and every element of the claimed invention is disclosed or suggested by the prior art. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Similarly, "[T]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP §2143.03.

The Applicants respectfully submit that each and every element of the presently claimed invention is not disclosed or suggested by the prior art. In particular, the prior art does not disclose or suggest a process of preparing a water absorbent resin composition by combining materials which have an iron content small enough so as to adjust the total iron content of the water-absorbent resin composition to 1 ppm or less as recited in claim 10. The prior art also does not disclose or suggest a process which produces a water-absorbent resin wherein discoloration resistance and gel stability are simultaneously improved also as recited in claim 10.

Obayashi '989 discloses a composition similar to that of the present invention, and which is said to have good gel stability. Obayashi '989 however fails to disclose or suggest a process

which comprises combining materials with an iron content that is small, so as to adjust the total iron content of the water-absorbent resin composition to 1 ppm or less, and such that discoloration resistance as well as gel stability can be improved. Therefore, the newly added process claims cannot be considered anticipated by, or obvious over, Obayashi '989.

In addition, with regard to claim 7 as currently amended, the present invention is distinguished by the fact that, although a large amount of water-absorbent resin is contained in the absorbent, unexpectedly superior results are simultaneously exhibited in both gel stability and discoloration resistance. However, in Obayashi '989 the amount of water-absorbent resin in the absorbent is only 33%. As noted above, the subject matter of the currently pending claim 8 is now incorporated into claim 7. Claim 7 now requires that the water-absorbent resin composition in the absorbent is 40 to 95% by weight. Obayashi '989 completely fails to disclose or suggest this limitation of claim 7.

## **Conclusion**

The Applicants respectfully submit that this application is in condition for allowance. An early reconsideration and notice of allowance are earnestly solicited.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee of \$120.00 is attached hereto.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact J. Mark Konieczny (Reg. No.

*Application No.: 10/540,832*  
*Reply to Office Action dated: August 24, 2006*

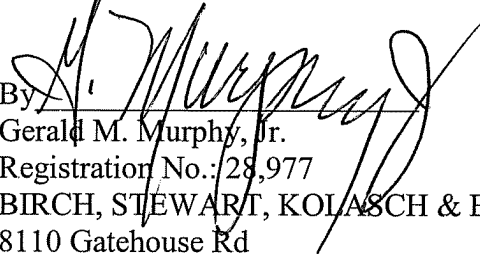
*Docket No.: 1422-0680PUS1*  
*Art Unit: 3761*

47,715 ) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: December 20, 2006

Respectfully submitted,

  
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